



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/665,497

09/22/2003

Takashi Shigemura

1259-0237P

6845

2292

7590

07/27/2005

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

HAUGLAND, SCOTT J

ART UNIT

PAPER NUMBER

3654

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EA

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,497	<b>Applicant(s)</b> SHIGEMURA, TAKASHI	
	<b>Examiner</b> Scott Haugland	<b>Art Unit</b> 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The hardness ranges recited in the claims (e.g., in the last line of claim 1) are indefinite since no units are specified. JIS K6253 covers Shore A and D scales.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas (U.S. Pat. No. 5,553,806) in view of Harkins (U.S. Pat. No. 2,353,462).

Lucas discloses a method of winding a web comprising winding the web into a roll and pressing a rotatable lay-on roll 12, 14, 15 against a peripheral surface of the roll. The lay-on roll includes a surface material formed in a cylindrical shape and including rubber having an effective Shore A hardness of 30-55 or 40-65 (abstract; col. 6, lines 20-26).

Lucas does not disclose that the lay-on roll has a surface material that includes rubber having the claimed volume resistivity.

Harkins teaches providing a material handling roller with an electrically conductive rubber cover having an electrical resistivity of  $20,000\ \Omega\ \text{cm}$  (p. 3, col. 1, lines 15-21) to prevent build up of static charge on the roller and handled material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lay-on roller of Lucas with a surface material having an electrical resistivity of  $20,000\ \Omega\ \text{cm}$  as taught by Harkins to prevent build up of static charge on the roller and the paper web.

Lucas discloses winding a paper web which is seen to be a polymer film as recited in claim 1 since paper comprises polymers. In addition, it would have been obvious to use the winding method of Lucas as modified for winding a continuous polymer film of another type (such as recited in claim 13) and to wind polymer webs having the claimed thicknesses (claims 8, 9) and width (claim 15) since the winder of Lucas would obviously have been capable of winding a wide range of web materials including ones having these claimed characteristics.

With regard to claim 6, it would have been obvious to use a material with high resistance to ozone to prolong its useful life.

With regard to claims 7, 10, 11, and 16, the selection of winding speed, pressing force, and material length to wind would have been a matter of obvious engineering choice since it would have been well within the level of skill of an ordinary artisan to select the appropriate values of these parameters for the particular web being wound.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Harkins as applied to claims 1, 10, and 11 above, and further in view of Perrigo (U.S. Pat. No. 5, 035,373).

Lucas does not disclose decreasing the pressing force of the lay-on roll on the film roll according to an increase in the radius of the film roll.

Perrigo teaches decreasing the pressing force of a lay-on roll on a web roll with increasing web roll radius (see abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to decrease the pressing force of the lay-on roll of Lucas as the radius of the web roll increases as taught by Perrigo to create a wound roll of the desired hardness. The particular pressing force to apply would have been a matter of obvious engineering choice depending on the material, roll size, width and other factors which are known to those of ordinary skill in the art.

Art Unit: 3654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (571) 272-6945. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*sjh*  
sjh  
7/18/05

*Kathy Matecki*

KATHY MATECKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600